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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,688	03/01/2004	Jeffrey Bergh	129843.1082 (H.072A)	2600
60148 7590 11/23/2007 GARDERE / JAMES HARDIE GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201			EXAMINER KENNEDY, JOSHUA T	
			ART UNIT 3679	PAPER NUMBER
			MAIL DATE 11/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,688

Applicant(s)

BERGH ET AL.

Examiner

Joshua T. Kennedy

Art Unit

3679

hk

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-15, 25-27, 29-33 and 68-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15, 25-27, 29-33 and 68-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

Claims 1-7, 9-15, 25-27, 29-33 and 68-71 have been examined.

Claims 8, 16-24, 28, 34-67 and 72-78 have been cancelled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-15, 25-27, 29-33 and 68-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caceres et al in view of Gleeson et al (US Patent Application Publication 2001/0047741).

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As to Claims 1-5, 9-12, 15, 25, 26, 31 and 68-70. Caceres et al disclose a fence system, comprising:

a horizontal mounting surface (15); and

a plurality of individual elongate members or pickets (13) attached to the horizontal mounting surface, wherein each individual member has an upper end, a lower end, a front surface, a back surface and a pair of sides adjoining the front surface and back surface, wherein the front surface and the back surface of each individual member is imprinted (or depressed) to form an imprinted front surface and an imprinted back surface (Examiner considers the shaping of each face into a desired texture, such as wood, creates an 'imprinted' or 'depressed' surface on the front and the back of each member since a surface texture of wood contains depressions and protrusions; Col 3, Lines 29-35), and wherein the plurality of individual members are made into a desired shape for use in the fence system prior to curing (Col 3, Lines 29-35) and wherein the front surface and back surface of the individual members are embossed with a pattern thereon resembling a wooden picket (Col 3, Lines 29-36), and the upper end of the plurality of individual members being formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1—Shows the pickets with a dog-eared shape), and

said plurality of pickets being installed generally perpendicular to a ground surface and in substantially parallel relationship to one another (Fig 1).

Caceres et al do not disclose the plurality of individual members being made of a plurality of layers of fiber cement whereby the plurality of individual members do not

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exhibit any substantial visible separation or fraying of the fibers along surfaces of the plurality of individual members after curing, wherein the fiber cement forming the plurality of individual members incorporates a low-density additive comprising microspheres or volcanic ash or a combination thereof to moisture resistant cellulose fibers.

Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has "applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking" (Par. 107, Lines 1-5). It would have been obvious to one of ordinary skill in the art to modify the plurality of individual members as taught by Caceres to be constructed of the fiber cement building material as taught by Gleeson et al because of its applicability to a number of building product applications, including fencing and it's a lightweight material with "workability at an economical price, as well as improved dimensional stability" (Par. 10) such as a lowered density of the material.

Examiner also notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

It is also noted that the limitations of "wherein such imprinted front surface and such imprinted back surface are not formed by molding the front and back surfaces or applying an external laminate" and "the fiber cement members are cut to size and shaped" impart limited patentable weight to the invention and that it is the patentability

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of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited.

Accordingly, it is of little consequence how the surfaces features formed or how the members are sized and shaped when all features and structure are present. See MPEP § 2113. The claimed structure matter appears to be met by the rejection, above, and therefore it has been held that if the product defined in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made from a different process. See In re Thorpe, 77 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).

As to Claims 6, 7, 18, 27, 29, 30, and 32. Caceres et al disclose the front surface and back surface of at least one individual member having a first surface, wherein the first surface has a finish that is has a pattern resembling wood and the color thereof or masonry (Col 3, Lines 29-36).

As to Claims 13 and 14. Caceres et al disclose the horizontal mounting surface comprising a pair of mounting rails (15) having a longitudinal axis, and the at least one individual member is positioned in a manner such that a longitudinal axis of the individual members (or pickets) is substantially perpendicular to the longitudinal axis of the horizontal mounting surface, wherein a first mounting rail is secured to the pickets at an upper location of the pickets, and a second mounting rail is secured to the pickets along a lower location of the pickets (Fig 1).

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As to Claim 33. Caceres et al disclose the picket capable of being nailed onto a fence rail (Col 2, Lines 19-22).

As to Claim 71. Caceres et al do not explicitly disclose a fence system wherein each of said pickets has a length between about 6 and 8 feet. However it is not inventive to state the optimum or workable values of the size of the pickets. As determined through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art to dimension each of said pickets to have an a length between about 6 and 8 feet so as to achieve the desired functionality and aesthetic appearance.

Claims 25-27, 29-33, and 68-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newberry, Jr. (US 3,801,072) in view of Gleeson et al (US Patent Application Publication 2001/0047741).

As to Claims 25, 26, 31, 68, and 70. Newberry, Jr. discloses a fence picket comprising a plurality of layers of fiberglass (Col 2, Lines 59-64), wherein the picket (11) has an upper end, a lower end, a front surface, a back surface and a pair or sides adjoining the front surface and back surface, and wherein the picket has a pattern formed on the front surface and back surface of the picket so as to form an imprinted (or depressed) front surface and an imprinted back surface (Examiner considers the molding of each panel to have certain surface features and texture, such as wood, creates an 'imprinted' or 'depressed' surface on the front and the back of each member since a surface texture of

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wood contains depressions and protrusions; Col 1, Lines 35-43), the pattern being applied to the front surface and to the back surface of the picket substantially simultaneously and the picket being made desired shape for use in the fence system prior to curing (Col 1, Lines 35-43),

the picket is secured to a the mounting surface (30) by a fastener passing through the front surface and the back surface of the individual member (Col 4, Lines 27-30) and into the mounting surface (30), and

the picket having at least one surface that has a pre-finish thereon resembling a wooden picket (Col 1, Lines 29-43); said plurality of pickets being installed generally perpendicular to a ground surface and in substantially parallel relationship to one another (Fig 1; Col 3, Lines 61-64).

It is noted that the limitation of "wherein such imprinted front surface and such imprinted back surface are not formed by molding the front and back surfaces or applying an external laminate" imparts limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the surfaces features formed when the features are present. See MPEP § 2113. The claimed structure matter appears to be met by the rejection, above, and therefore it has been held that if the product defined in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made

from a different process. See *In re Thorpe*, 77 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).

Newberry Jr. does not disclose the pickets being made of fiber cement whereby the plurality of individual members do not exhibit any substantial fraying of the fibers along surfaces of the pickets after curing, wherein the fiber cement forming the pickets incorporates a low-density additive comprising microspheres or volcanic ash or a combination thereof to moisture resistant cellulose fibers.

Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has "applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking" (Par. 107, Lines 1-5). It would have been obvious to one of ordinary skill in the art to modify the pickets as taught by Newberry to be constructed of the fiber cement building material as taught by Gleeson et al because of its applicability to a number of building product applications, including fencing and it's a lightweight material with "workability at an economical price, as well as improved dimensional stability" (Par. 10) such as a lowered density of the material.

Examiner also notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

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As to Claim 69. Newberry Jr. discloses the upper end of at least one individual member being formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1—Shows the pickets with a dog-eared shape).

As to Claims 27 and 32. Newberry Jr. discloses the front surface and back surface of at least one individual member having a first surface, wherein the first surface has a finish that is capable of resembling wood or the color thereof or masonry (Col 1, Lines 39-43).

As to Claims 29 and 30. Newberry Jr. discloses at least one exterior surface of the picket being stained or being textured (Col 1, Lines 39-43).

As to Claim 33. Newberry Jr. discloses the picket capable of being nailed onto a fence rail (Col 4, Lines 27-30).

As to Claim 71. Newberry Jr. discloses a fence system wherein each of said pickets has a length between about 6 and 8 feet (Col 2, Lines 5-7).

Response to Arguments

Applicants' arguments filed 10/31/2007 with respect to claims 1-7, 9-15, 25-27, 29-33 and 68-71 have been fully considered but they are not persuasive.

As to the claims, Applicants argue:

"Applicants submit that one of skill in the art would not be motivated or have any reasonable expectation of success of modifying Caceres' fiberglass fencing panel ... to yield a fencing system employing individual fiber cement members, "wherein the front and the back surfaces of each individual member are imprinted to form an imprinted front surface and an imprinted back surface, wherein such imprinted front surface and such imprinted back surface are not formed by molding the front and back surfaces or applying an external laminate" ...neither of the references, alone or in combination, recite a fence system having a plurality of individual fiber cement members which comprise fiber cement having fibers, each having a front and back surface, which "contain an embossed pattern such that one or more fibers along the front surface and the back surface are depressed relative to other fibers in the fiber cement" as recited in Applicants' present claim 15. Further, neither of the references, alone or in combination, recite elongated members made of fiber cement, wherein the elongated member has a pattern formed on its front and back surface,"such that one or more fibers along the front surface and the back surface are depressed relative to other fibers in the fiber cement" as recited in Applicants' present claim 68." (Pages 7-8)

Examiner respectfully disagrees. A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not

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construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976). The limitations regarding the imprinting/depressing of the front and back surfaces of the members impart limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. It is also noted, that as advanced in the rejections above, Caceras, Newberry, Jr. and Gleeson teach the provision of the structure of the members being having imprints/ depressions, which may require different methods of forming of the members, which is all that is required by the claimed limitations. Regardless, it is of little consequence how (or when) the members are sized and shaped when all claimed structure is present. See MPEP § 2113.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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